

REMARKS

The Official Action mailed April 8, 2004, has been received and its contents carefully noted. A *Notice of Appeal* was filed with a *Request for Two Month Extension of Time* on September 8, 2004. Filed concurrently herewith is a *Request for Four Month Extension of Time*, which extends the shortened statutory period for response to March 8, 2005. Also, filed concurrently herewith is a *Request for Continued Examination*. Accordingly, the Applicants respectfully submit that this response is being timely filed.

The Applicants note with appreciation the full consideration of the Information Disclosure Statements filed on September 20, 2002, and January 30, 2004.

Regarding the IDSs filed November 2, 2001 (received by OIPE on January 16, 2002), November 30, 2001 (received by OIPE on January 4, 2002), April 18, 2002 (received by OIPE April 29, 2002), and May 9, 2003 (received by OIPE on May 12, 2003), the Official Action states that "no papers in the file match the indicated dates ... if there are others than have been omitted, please resubmit them" (page 6, Paper No. 04022004). The Official Action also states "even if they were submitted, if they are not currently in the file there is no way to consider them" (Id.).

Regarding the IDS filed on November 2, 2001 (received by OIPE on January 16, 2002), it does not appear that the IDS and PTO 1449 forms filed November 2, 2001, were scanned into IFW. In response, the Applicants respectfully submit that an Information Disclosure Statement (1 page) and PTO 1449 forms (8 pages) were filed on November 2, 2001, and received by OIPE on January 16, 2002, as evidenced by the attached copy of the stamped received post card. The Applicants have also provided a copy of the IDS and 1449 forms as filed. References cited in this IDS are to be found in the copending applications Serial Nos. 08/943,333 (abandoned), 08/372,899 (pending), 07/993,391 (abandoned) and 07/837,394 (issued as U.S. Patent No. 5,200,846).

Under 37 CFR 1.98(d)(1), the Applicants are permitted to rely on an earlier submission of prior art in a parent application if the "earlier application is properly identified in the information disclosure statement and is relied on for an earlier effective

filing date under 35 U.S.C. 120.” The Applicants respectfully submit that copies of the references cited in the Information Disclosure Statement are available in the copending parent applications, Serial Nos. 08/943,333, 08/372,899, 07/993,391 and 07/837,394. The above-referenced applications are properly identified in the Information Disclosure Statement, and the application data sheet shows that the present application claims the benefit of priority from the above-referenced applications. As such, the Applicants respectfully submit that the Information Disclosure Statement fully complies with 37 CFR 1.98 and must be considered by the Examiner. As stated in MPEP § 609.III.C(2), “items of information listed that do comply with the requirements of 37 CFR 1.97 and 37 CFR 1.98 will be considered by the examiner and will be appropriately initialed” (emphasis added).

It is noted that it has come to the Applicants attention that the above-referenced IDS contains three minor errors, which have been corrected in the attached copies of the PTO 1449 forms. Specifically, on page 1 of 8, “McGrievy” has been changed to “McGreivy”; on page 2 of 8, “Moruzumi” has been changed to “Morozumi”; and on page 5 of 8, JP 02-349415 was cited in error.

If there are any particular references that cannot be located by the Examiner in Serial Nos. 08/943,333, 08/372,899, 07/993,391 and 07/837,394 applications, the Applicants request that such references be identified in a subsequent communication. If the Examiner is unable to comply with the rules, it is respectfully requested that the Examiner discuss the matter with the Director of the Technology Center to find out what other remedies may be available.

It is noted that the Applicants are merely resubmitting the above documents as a courtesy to the Examiner. It is respectfully submitted that the above-referenced Information Disclosure Statement was properly filed on November 2, 2001, and should be accorded its filing date for the purposes of consideration and compliance with 37 CFR 1.97 and 1.98.

Regarding the IDS filed on November 30, 2001 (received by OIPE on January 4, 2002), the Applicants received an unsigned and uninitialed copy of the PTO 1449 form with the Official Action mailed July 21, 2003 (Paper No. 6), a copy of which is attached. The IDS itself appears in private PAIR as "01/04/2002 Information Disclosure Statement PROSECUTION 2 [pages]" and should be available to the Examiner in IFW. U.S. Patent No. 5,162,901 should be readily accessible to the Examiner. JP 64-068728 appears in private PAIR as "01/04/2002 Foreign Reference PRIOR ART 9 [pages]" and should be available to the Examiner in IFW. Therefore, all pertinent documents are available to the Examiner and the IDS filed November 30, 2001, should be considered in due course.

Regarding the IDS filed April 18, 2002 (received by OIPE April 29, 2002), the Applicants received a partially considered copy of the PTO 1449 form with the Official Action mailed July 21, 2003 (Paper No. 6), a copy of which is attached. Specifically, as previously noted by the Applicants, it appears the Examiner overlooked the citation of U.S. Patent No. 5,340,999 to Takeda et al. U.S. Patent No. 5,340,999 should be readily accessible to the Examiner. Therefore, all pertinent documents are available to the Examiner and the IDS filed April 18, 2002, should be fully considered in due course.

Regarding the IDS filed May 9, 2003 (received by OIPE May 12, 2003), the entire IDS including the five JP references cited therein are clearly shown in PAIR/IFW as "05/12/2003 Information Disclosure Statement PROSECUTION 3 [pages]" and "05/12/2003 Foreign Reference PRIOR ART 6 [pages]," 6 pages, 10 pages, 12 pages and 8 pages, respectively. Therefore, all pertinent documents are available to the Examiner and the IDS filed May 9, 2003, should be fully considered in due course.

A further IDS was filed by the Applicants on June 16, 2004 (received by OIPE June 18, 2004), and is fully available in PAIR/IFW.

A further IDS is submitted herewith.

The Applicants respectfully request that the Examiner provide an initialed copy of the Form PTO-1449 evidencing consideration of the above-referenced Information Disclosure Statements.

Claims 1-23 were pending in the present application prior to the above amendment. Claims 1, 3, 5, 10-14, 16-18, 20, 22 and 23 have been canceled, claims 2, 4, 6-9, 15, 19 and 21 have been amended to better recite the features of the present invention, and new claims 24-58 have been added to recite additional protection to which the Applicants are entitled. Accordingly, claims 2, 4, 6-9, 15, 19, 21 and 24-58 are now pending in the present application, of which claims 2, 4, 6-9, 26-31, 37-42 and 48-53 are independent. For the reasons set forth in detail below, all claims are believed to be in condition for allowance. Favorable reconsideration is requested.

The Official Action rejects claims 2, 4 and 6-23 as obvious based on the combination of U.S. Patent No. 5,003,356 to Wakai et al, U.S. Patent No. 5,358,810 to Yoshino, U.S. Patent No. 5,042,920 to Yoshino et al. and Bahadur, "Liquid Crystal Devices and Uses," Vol. 1, World Scientific Press 1990, pages 178-181 and 421-423. The Applicants respectfully submit that a *prima facie* case of obviousness cannot be maintained against the independent claims of the present application, as amended.

As stated in MPEP §§ 2142-2143.01, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of

one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.” In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

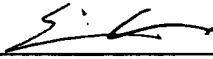
The prior art, either alone or in combination, does not teach or suggest all the features of the independent claims, as amended. Independent claims 2, 4 and 6-9 have been amended to recite a leveling film and a gate insulating film containing fluorine. Wakai, Yoshino and Bahadur, either alone or in combination, do not teach or suggest at least the above-referenced features of the present invention. Furthermore, it is noted that the above-referenced features were found to be allowable subject in the counterpart Japanese patent application.

Since Wakai, Yoshino and Bahadur do not teach or suggest all the claim limitations, a *prima facie* case of obviousness cannot be maintained. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) are in order and respectfully requested.

New claims 24-58 have been added to recite additional protection to which the Applicants are entitled. For the reasons stated above and already of record, the Applicants respectfully submit that new claims 24-58 are in condition for allowance.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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21010 Southbank Street
Potomac Falls, Virginia 20165
(571) 434-6789

Amendments to the Drawings:

The attached sheets of drawings include formal versions of Figures 1-38. These sheets, which include Figures 1-38, replace the original sheets including Figures 1-38.

Attachment: Replacement Sheets

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re New **DIVISIONAL** Application of:)
Masaaki HIROKI) Art Unit: 2871
Based on U.S. Serial No. 08/943,333) Examiner: K. Parker
Filed on: October 3, 1997)
For: ELECTRO-OPTICAL DEVICE)

INFORMATION DISCLOSURE STATEMENT

Commissioner for Patents and Trademarks
Washington, D.C. 20231

Sir:

In accordance with the provisions of 37 C.F.R. 1.56 and 37 C.F.R. 1.97-1.99, it is requested that the reference(s) listed on the attached Form PTO-1449 be made of record in the above-identified application.

The references listed on the attached Form PTO-1449 were cited in parent application Serial No. 08/943,333 and the predecessor applications including Serial Nos. 08/372,899; 07/993,391 and 07/837,394.

Respectfully Submitted,

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to: Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513, on 11/2/2001

Eric J. Robinson
Registration No. 38,285

Nixon Peabody LLP
8180 Greensboro Drive, Suite 800
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(703) 790-9110

COPY



This will acknowledge receipt of the following:

1. Information Disclosure Statement with Certificate of Mailing
2. Form PTO-1449

In re New **DIVISIONAL** Application of:

Masaaki HIROKI

Based on U.S. Serial No. 08/943,333

Filed on: October 3, 1997

For: ELECTRO-OPTICAL DEVICE

Due date: 12/24/2001

Docket No. 740756-2367

EJR/mlc



11/2/2001



Form PTO-1449
(Rev. 8-83)U.S. Department of Commerce
Patent and Trademark Office

Atty Docket 0756-230

Serial No. 09/961,055

INFORMATION DISCLOSURE STATEMENT

Applicants: Masaaki HIROKI et al.

Filing Date: September 24, 2001

Group Art Unit: N/A

MAR 11 2005

U.S. PATENT DOCUMENTS

Examiner Initial	Document Number	Date	Name	Class	Subclass	Filing Date (if appropriate)
	3,798,752	03/26/1974	Fujimoto			
	3,838,209	09/24/1974	Tsuchiya et al.			
	3,955,187	05/04/1976	Bigelow			
	4,021,607	05/03/1977	Amano			
	4,068,020	01/10/1978	Reuschel			
	4,103,297	07/25/1978	McGrievy et al. McGreivy et al.			
	4,239,346	12/16/1980	Lloyd			
	4,365,013	12/21/1982	Ishioka			
	4,378,417	03/29/1983	Maruyama et al.			
	4,420,870	12/20/1983	Kimura			
	4,427,978	01/24/1984	Williams			
	4,466,172	08/21/1984	Batra			
	4,468,855	09/04/1984	Sasaki			
	4,528,480	07/09/1985	Unagami			
	4,591,892	05/27/1986	Yamazaki			
	4,597,160	07/01/1986	Ipri			
	4,597,637	07/01/1986	Ohta			
	4,600,274	07/15/1986	Morozumi			
	4,646,426	03/03/1987	Sasaki			
	4,649,432	03/10/1987	Watanabe et al.			
	4,650,543	03/17/1987	Kishita et al.			
	4,653,862	03/31/1987	Morozumi			
	4,660,030	04/21/1987	Maezawa			
	4,680,580	07/14/1987	Kawahara			
	4,716,403	12/29/1987	Morozumi			
	4,727,044	02/23/1988	Yamazaki			
	4,740,829	04/26/1988	Nakagiri et al.			
	4,742,346	05/03/1988	Gillette et al.			
	4,743,096	05/10/1988	Wakai et al.			
	4,752,774	06/21/1988	Clerc et al.			
	4,755,865	07/05/1988	Wilson et al.			

Examiner

Date Considered

*EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

10/16/2001

Form PTO-1449
(Rev. 8-83)Department of Commerce
Patent and Trademark Office

Atty Docket 0756-2501

Serial No. 09/961,055

INFORMATION DISCLOSURE STATEMENT

Applicants: Masaaki HIROKI et al.

Filing Date: September 24, 2001

Group Art Unit: N/A

U.S. PATENT DOCUMENTS

Examiner Initial	Document Number	Date	Name	Class	Subclass	Filing Date (if appropriate)
	4,770,502	09/13/1988	Kitazima et al.			
	4,818,077	04/04/1989	Ohwada et al.			
	4,818,981	04/04/1989	Oki et al.			
	4,838,654	06/13/1989	Hamaguchi et al.			
	4,841,294	06/20/1989	Clerc			
	4,860,069	08/22/1989	Yamazaki			
	4,862,237	08/29/1989	Morozumi Morozumi			
	4,873,516	10/10/1989	Castleberry			
	4,888,305	12/19/1989	Yamazaki et al.			
	4,891,330	01/02/1990	Guha et al.			
	4,897,360	01/30/1990	Guckel et al.			
	4,897,639	01/30/1990	Kanayama			
	4,905,066	02/27/1990	Dohjo et al.			
	4,916,090	04/10/1990	Motai et al.			
	4,938,565	07/03/1990	Ichikawa			
	4,943,837	07/24/1990	Konishi et al.			
	4,949,141	08/14/1990	Busta			
	4,959,700	09/25/1990	Yamazaki			
	4,960,719	10/02/1990	Tanaka et al.			
	4,969,025	11/06/1990	Yamamoto et al.			
	4,969,031	11/06/1990	Kobayashi et al.			
	4,973,135	11/27/1990	Okada et al.			
	4,986,213	01/22/1991	Yamazaki et al.			
	4,988,643	01/29/1991	Tsou			
	5,003,356	03/26/1991	Wakai et al.			
	5,012,228	04/30/1991	Masuda et al.			
	5,016,610	05/21/1991	Meguro et al.			
	5,023,679	06/11/1991	Shibata			
	5,051,570	09/24/1991	Tsujikawa et al.			
	5,055,899	10/08/1991	Wakai et al.			
	5,056,895	10/15/1991	Kahn			

Examiner

Date Considered

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10/16/2001

Form PTO-1449
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INFORMATION DISCLOSURE STATEMENT

Applicants: Masaaki HIROKI et al.

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U.S. PATENT DOCUMENTS

Examiner Initial	Document Number	Date	Name	Class	Subclass	Filing Date (if appropriate)
	5,077,223	12/31/1991	Yamazaki			
	5,084,905	01/28/1992	Sasaki et al.			
	5,091,722	02/25/1992	Kitajima et al.			
	5,093,703	03/03/1992	Minami et al.			
	5,102,361	04/07/1992	Katayama et al.			
	5,132,754	07/21/1992	Serikawa et al.			
	5,132,821	07/21/1992	Nicholas			
	5,142,272	08/25/1992	Kondo			
	5,142,344	08/25/1992	Yamazaki			
	5,182,620	01/26/1993	Shimada et al.			
	5,194,136	03/16/1993	Jeung et al.			
	5,196,839	03/23/1993	Johary et al.			
	5,200,846	04/06/1993	Hiroki et al.			
	5,206,635	04/27/1993	Inuzuka et al.			
	5,235,195	08/10/1993	Tran et al.			
	5,245,452	09/14/1993	Nakamura et al.			
	5,250,818	10/05/1993	Saraswat et al.			
	5,250,931	10/05/1993	Misawa et al.			
	5,273,910	12/28/1993	Tran et al.			
	5,287,205	02/15/1994	Yamazaki et al.			
	5,289,030	02/22/1994	Yamazaki et al.			
	5,302,845	04/12/1994	Kumagai et al.			
	5,308,998	05/03/1994	Yamazaki et al.			
	5,313,077	05/17/1994	Yamazaki			
	5,315,132	05/24/1994	Yamazaki et al.			
	5,327,001	07/05/1994	Wakai et al.			
	5,327,901	07/12/1994	Delente			
	5,329,390	07/12/1994	Fujiwara et al.			
	5,341,012	08/23/1994	Misawa et al.			
	5,358,810	10/25/1994	Yoshino			
	5,408,246	04/18/1995	Inaba et al.			

Examiner

Date Considered

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INFORMATION DISCLOSURE STATEMENT

Applicants: Masaaki HIROKI et al.

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U.S. PATENT DOCUMENTS

Examiner Initial	Document Number	Date	Name	Class	Subclass	Filing Date (if appropriate)
	5,414,443	05/09/1995	Kanatani et al.			
	5,495,353	02/27/1996	Yamazaki et al.			
	5,521,107	05/28/1996	Yamazaki et al.			
	5,543,636	08/06/1996	Yamazaki			
	5,568,288	10/22/1996	Yamazaki et al.			
	5,612,799	03/18/1997	Yamazaki et al.			
	5,744,818	04/28/1998	Yamazaki et al.			
	5,854,879	12/29/1998	Inuzuka et al.			
	5,933,205	08/03/1999	Yamazaki et al.			
	5,956,105	09/21/1999	Yamazaki et al.			
	5,963,278	10/05/1999	Yamazaki et al.			
	6,013,928	01/11/2000	Yamazaki et al.			
	RE 33,882	04/14/1992	Morozumi			

FOREIGN PATENT DOCUMENTS

Examiner Initial	Document Number	Date	Country	Class	Subclass	Translation	
						Yes	No
	0 161 555	11/21/1985	EP			Full Eng	
	0 321 073	06/21/1989	EP				X
	0 349 415	01/03/1990	EP				X
	0 412 701	02/13/1991	EP			Full Eng	
	01-068732	03/14/1989	JP			Eng Abst	
	01-107237	04/25/1989	JP			Eng Abst	
	01-130131	05/23/1989	JP				X
	01-156725	06/20/1989	JP			Full Eng	
	01-183845	07/21/1989	JP			Eng Abst	
	01-183853	07/21/1989	JP			Full Eng	
	01-194351	08/04/1989	JP			Eng Abst	
	01-241862	09/26/1989	JP			Full Eng	
	01-274117	11/01/1989	JP			Eng Abst	
	01-289917	11/21/1989	JP			Eng Abst	
	02-002522	01/08/1990	JP			Eng Abst	

Examiner

Date Considered

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Form PTO-1449
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Applicants: Masaaki HIROKI et al.

Filing Date: September 24, 2001

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FOREIGN PATENT DOCUMENTS

Examiner Initial	Document Number	Date	Country	Class	Subclass	Translation	
						Yes	No
	02-016596	01/19/1990	JP			Eng Abst	
	02-027320	01/30/1990	JP			Eng Abst	
	02-051129	02/21/1990	JP				X
	02-090683	03/30/1990	JP			Eng Abst	
	02-103925	04/17/1990	JP			Eng Abst	
	02-159730	06/19/1990	JP			Full Eng	
	02-188723	07/24/1990	JP			Eng Abst	
	02-199498	08/07/1990	JP			Eng Abst	
	02-210330	08/21/1990	JP			Full Eng	
	02-211428	08/22/1990	JP			Eng Abst	
	02-228041	09/11/1990	JP			Eng Abst	
	02-228042	09/11/1990	JP			Eng Abst	
	02-234134	09/17/1990	JP			Full Eng	
	02-278749	11/15/1990	JP			Full Eng	
	02-281291	11/16/1990	JP			Eng Abst	
	02-307273	12/20/1990	JP			Eng Abst	
	02-309317	12/25/1990	JP			Eng Abst	
	02-349415	03/01/1990	JP				X
	03-007911	01/16/1991	JP			Eng Abst	
	03-017629	01/25/1991	JP			Eng Abst	
	03-024735	02/01/1991	JP			Eng Abst	
	03-034434	02/14/1991	JP			Eng Abst	
	03-059543	03/14/1991	JP			Full Eng	
	03-109739	05/09/1991	JP			Eng Abst	
	03-165575	07/17/1991	JP			Eng Abst	
	03-180058	08/06/1991	JP			Eng Abst	
	03-185839	08/13/1991	JP			Eng Abst	
	03-217059	09/24/1991	JP			Eng Abst	
	03-272183	12/03/1991	JP			Eng Abst	
	03-288824	12/19/1991	JP			Eng Abst	
	04-015956	01/21/1992	JP			Eng Abst	

Examiner

Date Considered

*EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

10/16/2001

Form PTO-1449
(Rev. 8-83)U.S. Department of Commerce
Patent and Trademark Office

Atty Docket 0756-25

Serial No. 09/961,055

INFORMATION DISCLOSURE STATEMENT

Applicants: Masaaki HIROKI et al.

Filing Date: September 24, 2001

Group Art Unit: N/A

FOREIGN PATENT DOCUMENTS

Examiner Initial	Document Number	Date	Country	Class	Subclass	Translation	
						Yes	No
	04-283729	10/08/1992	JP			Full Eng	
	04-291240	10/15/1992	JP			Full Eng	
	04-299864	10/23/1992	JP			Eng Abst	
	04-360580	12/14/1992	JP			Eng Abst	
	05-267667	10/15/1993	JP			Eng Abst	
	1 396 486	06/04/1975	UK			Full Eng	
	2 130 781	06/06/1984	UK			Full Eng	
	2 187 859	09/16/1987	UK			Full Eng	
	49-052598	05/22/1974	JP			Eng Abst	
	49-077537	07/26/1974	JP				X
	52-076897	06/28/1977	JP			Eng Abst	
	53-027483	03/14/1978	JP			Full Eng	
	53-144297	12/15/1978	JP			Full Eng	
	55-032026	03/06/1980	JP			Full Eng	
	55-154750	12/02/1980	JP			Eng Abst	
	58-002073	01/07/1983	JP			Full Eng	
	58-023478	02/12/1983	JP			Eng Abst	
	58-023479	02/12/1983	JP			Eng Abst	
	58-027365	02/18/1983	JP			Full Eng	
	58-105574	06/23/1983	JP			Eng Abst	
	58-106861	06/25/1983	JP			Eng Abst	
	58-115864	07/09/1983	JP			Eng Abst	
	58-118154	07/14/1983	JP			Full Eng	
	58-142566	08/24/1983	JP			Eng Abst	
	58-164268	09/29/1983	JP			Eng Abst	
	58-186967	11/01/1983	JP			Eng Abst	
	58-192379	11/09/1983	JP			Full Eng	
	59-021067	02/02/1984	JP			Eng Abst	
	59-061818	04/09/1984	JP			Eng Abst	
	60-047574	03/14/1985	JP			Eng Abst	
	60-154996	10/16/1985	JP			Conc Stmt	

Examiner

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Applicants: Masaaki HIROKI et al.

Filing Date: September 24, 2001

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